REMARKS/ARGUMENTS

Claims 1-3, 5-7, 9-11, 16, 17 and 22-24 are pending in the present application. Claims 1-3, 5, 7, 9-11, 16, 17 and 23 have been amended, Claims 8, 12, 14, 18 and 20-21 were previously cancelled, and Claims 4, 13, 15 and 19 have been cancelled, herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. §112, First Paragraph

The Examiner has objected to the specification under 35 U.S.C. §112, first paragraph, as failing to adequately teach how to make and/or use the invention in Claims 1-7, 9-11, 13, 15-17, 19 and 22-24. Additionally, the Examiner rejected the claims under the same reasons. This rejection is respectfully traversed.

In rejecting Claims 1, 5, 10 and 16, the Examiner states that support for the exclusionary statement "without user intervention" is not found in the original disclosure of the instant application and must be deleted from the claims in response to this action. While Applicants deny such assertion (*Applicants respectfully submit that the original disclosure does in fact describe such automated action without user intervention with respect to the determining step, as described at Specification page 15, line 28 – page 16, line 6*), Applicants have in any event deleted this objectionable language to expeditiously place this case in condition for allowance, as it is redundant with the term 'automatically'.

In rejecting Claims 1, 5, 9, 10, 16 and 23, the Examiner states that the original disclosure fails to provide support for the subject matter as now claimed, since the term "actual picture image" is not supported by the Specification. While Applicants deny such assertion (Applicants respectfully submit that the original Specification describes that the pictures of the users are "mug shots" at Specification page 12, lines 8-10, and the term "mug shots" is commonly known to those of ordinary skill in the art to be actual picture images of users), Applicants have in any event deleted the objectionable word "actual" in order to expeditiously place this case in condition for allowance. However, it should be noted that pictures of users, images of users and mug shots of users are used extensively throughout the original specification, and thus the deletion of this term is not a disclaimer that the pictures or images of the user are not actual pictures of the user, as that is exactly what a mug shot is (a mug shot being commonly known to be a picture, image or photograph of a person that includes the person's face).

Therefore, the objection to the Specification and the rejection of Claims 1-7, 9-11, 13, 15-17, 19 and 22-24 under 35 U.S.C. §112, first paragraph has been overcome.

II.   35 U.S.C. §101

Claims 16, 17, 19 and 22 stand rejected under 35 U.S.C. §101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

As stated in MPEP 2106(IV)(B)(1)(a): A claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Thus, these types of claims as recited in Claims 16, 17, 19 and 22 are explicitly defined to be 35 USC §101 statutory subject matter pursuant to MPEP 2106(IV)(B)(1)(a).

Still further, while Applicants acknowledge that an abstract idea, law of nature, or natural phenomenon in and of itself is non-statutory, a practical application or use of an idea, a law of nature or a natural phenomenon does not fall under such blanket exclusion[1]. Claims 16, 17, 19 and 22 do not preempt any type of abstract idea, law of nature or natural phenomenon and thus do not fall within one of the judicial exceptions. And as described above, the MPEP itself expressly acknowledges that these claims are in proper form for purposes of 35 USC §101. Accordingly, it is urged that these claims do in fact recite statutory subject matter as expressly allowed by the MPEP; they do not fall within one of the judicial exceptions to 35 USC §101; they do not preempt any type of abstract idea, law of nature or natural phenomenon; and that they provide a practical application of handling instant messages in a data processing system. Accordingly, these claims have been improperly rejected under 35 USC §101.

Therefore, the rejection of Claims 16, 17, 19 and 22 under 35 U.S.C. §101 has been overcome.

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[1] MPEP 2106(IV)(A): The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 ("steps of 'locating' a medial axis, and 'creating' a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic 'abstract idea'").

**The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right."); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter).

**Accordingly, one may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent would "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

III.   35 U.S.C. §103, Obviousness

Claims 1-4, 9-11, 13, 15-17, 19 and 22 stand rejected under 35 U.S.C. §103 as being unpatentable over *Crawford* (US Patent # 6,781,608) in view of *Clark et al.* (US Patent Application Publication # US 2002/0174188 A1) in view of *Miller et al.* (US Patent Application Publication # US 2005/0004993 A1) . This rejection is respectfully traversed.

Claim 1 has been amended to include certain features previously recited in Claim 4 (which is thus being cancelled herewith without prejudice or disclaimer). As amended, Claim 1 recites "wherein the picture image of the sender is stored in the preexisting database on the remote data processing system, and the preexisting database is used to provide pictures of users for a different user identification purpose other than instant messaging". As can be seen, the preexisting database (where the picture image of the sender is stored) is used to provide pictures of users for a different user identification purpose other than instant messaging. In rejecting Claim 4 (certain of whose features are now a part of independent Claim 1), the Examiner cites *Clark's* teachings at paragraphs 0006-0007 as teaching such dual-purpose database. Applicants respectfully submit that this database is not used to store a picture image of a user that is used for both (1) instant messaging (Claim 1 recites "responsive to receiving an instant message, determining whether an picture image of a sender of the instant message is associated with the instant message, wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system as determined by a user selected preference, and *wherein the determining step is automatically performed by an instant messaging process of a receiver of the instant message that determines whether the picture image of the sender is in the local cache or the preexisting database of pictures*"), and (2) a different identification purpose other than instant messaging (Claim 1 also recites "the preexisting database is used to provide pictures of users for a different user identification purpose other than instant messaging"). Thus, as this cited passage of *Clark* does not teach such a dual-purpose database, it is urged that Claim 1 is not obvious in view of the cited references as there are claimed features that are not taught or suggested by any of the cited references.

Still further with respect to Claim 1, none of the cited references teach or suggest that their buddy icon is a mug shot of the sender of the message, as expressly recited in Claim 1. Instead, *Crawford* teaches generic buddy icons – and these are not described as being a picture or image of a sender of the message. Thus, it is further urged that a proper *prima facie* case of obviousness has not been established with respect to Claim 1. The generic buddy icons do not help a recipient of a message to recall the sender's identity, as do the features of Claim 1 (Specification page 11, lines 1-8), as they are generic and available for use by anyone using the IM system. In contrast, by providing a picture image of the user themselves who is sending the IM message, the receiver of the message is able to instantly visually

identify the sender of the image, which is particularly advantageous since many users do not use their real name when sending messages – instead using made-up screen names which are many times difficult to cross-reference or otherwise correlate with who the sender really is.

Thus, it is thus respectfully submitted that Claim 1 is not obvious in view of the cited references, as there are claimed features not taught or suggested by the cited references.

Applicants traverse the rejection of Claims 2 and 3 for reasons given above with respect to Claim 1 (of which Claims 2 and 3 depend upon).

With respect to Claim 9, such claim recites "the processing unit executes the set of instructions to determine whether a picture image of a sender of the instant message is associated with the instant message in response to receiving an instant message, wherein the picture image of the sender is located in a preexisting database of pictures, and display the picture image of the sender with the instant message on a display in the data processing system if the picture image of the sender is associated with the instant message, wherein *the picture image of the sender is* _attached to the instant message by a separate server_ _data processing system,_ _while the instant message is in transit from the sender to the data processing_ _system,_ _as determined by an indicator in the instant message_". As can be seen, a separate server provides in-transit attachment of an image of the sender as determined by an indicator in the instant message itself. In rejecting this aspect of Claim 9, the Examiner cites *Clark's* database 120 as depicted in *Clark's* Figure 1C as teaching this claimed feature. Applicants respectfully submit that this database 120 is a part of contact exchange server 102 that is used to either (i) deliver profile information to a destination computer or device, or (ii) notify the destination computer/device so that the profile information can be fetched from the contact exchange server (*Clark* paragraph 0023). This is different from what is recited in Claim 9 for at least two reasons. First, this cited reference does not teach or otherwise suggest attachment of a picture image of a sender *to the instant message* _while the instant message is in transit_ from a sender to a data processing system. Rather, a standalone profile is sent – i.e. this sending of profile information from a database is not used with and does not facilitate a sending of an instant message. Second, there is no teaching or suggestion that the (missing) instant message has any type of indicator within the instant message itself that is used to determine whether to attach the picture image of the sender to the (missing) instant message by a server while the instant message is in transit. Rather, a target sender subsystem *within the contact exchange server itself* determines how to send the profile (*Clark* paragraph 0032). Thus, for at least these two reasons, it is respectfully submitted that there are claimed features not taught or suggested by any of the cited references, and thus Claim 9 is not obvious in view of such cited references.

Applicants traverse the rejection of Claims 10 (and dependent Claims 11, 13 and 15) and 16 (and dependent Claims 17, 19 and 22) for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1-4, 9-11, 13, 15-17, 19 and 22 under 35 U.S.C. §103 has been overcome.

IV.   35 U.S.C. §103, Obviousness

Claims 5-7, 23 and 24 stand rejected under 35 U.S.C. §103 as being unpatentable over *Crawford* (US Patent # 6,781,608) in view of *Ostermann et al.* (US Patent # 6,990,452). This rejection is respectfully traversed.

With respect to Claim 5, such claim recites "displaying the picture image of the sender with the instant message on a display in the data processing system if the picture image of the sender is associated with the instant message, wherein the *picture image of the sender* is embedded *by an instant messaging process of the sender* into the instant message prior to sending the instant message to the data processing system, and wherein the picture image of the sender is a selected picture that is selected from a plurality of *different picture images of the sender*, the selected picture being automatically selected by the instant messaging process based upon particular content *in the instant message*". As can be seen, a picture image of the sender is embedded *by an instant messaging process of the sender*, and the picture image of the sender that is embedded is *selected from a plurality of different picture images of the sender* based on particular content in the instant message. In rejecting this aspect of Claim 5, the Examiner cites *Ostermann's* teaching at col. 8, lines 51-52 and col. 9, lines 16-34 as teaching theses claimed features. Applicants respectfully submit that this passage is different from what is claimed for numerous reasons. First, rather than teaching that a picture image of a sender is embedded by an instant messaging process of the sender, the cited reference instead teaches use of a sophisticated, dedicated animation server that is used to create a video animation of a message (col. 5, lines 16-34), and this video does not include a picture image of the sender but rather a computer generated face (col. 1, lines 38-40). Second, there is no teaching of a plurality of different images *of the sender* that are used when selecting a given picture image of the sender. Instead, the cited reference generates animated sequences of animated entities by a special animated server (col. 5, lines 28-34). Thus, as there are several claimed features not taught or suggested by any of the cited references, it is respectfully submitted that Claim 5 is not obvious in view of the cited references.

Applicants traverse the rejection of Claims 6 and 7 for reasons given above with respect to Claim 5 (of which Claims 6 and 7 depend upon).

Applicants traverse the rejection of Claim 23 (and dependent Claim 24) for substantially the same reasons as those given above with respect to Claim 5.

Therefore, the rejection of Claims 5-7, 23 and 24 under 35 U.S.C. §103 has been overcome.

V. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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